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10/605,879

11/03/2003

James W. Wieder

W03-003

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11/12/2009

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EXAMINER

GREENE, DANIEL LAWSON

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

11/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-----------------------------------------|-----------------------------------------|--|
| Office Action Summary | Application No. 10/605,879 | Applicant(s) WIEDER, JAMES W. | |
| | Examiner DANIEL L. GREENE JR. | Art Unit 3694 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 163-170,174-176,211-213,217,218 and 232-263 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 163-170,174-176,211-213,217,218 and 232-263 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/13/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants 8/15/2009 response to the 4/16/2009 Office action has been considered and entered. Claims 163-170, 174-176, 211-213, 217, 218 and 232-263 are pending and have been examined on the merits as explained below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/15/2009 has been entered.

Response to Arguments

3. **Applicant's arguments spanning on pages 12 and 13, regarding the Admission of prior art set forth in section 2 of the previous Office action mailed has been considered, but they are not persuasive.**

Applicant argues:

Comments on Office Action assertion in item 2: The Office Action stated that "during the interview on 11/19/2008 the applicant acquiesced to ...". The applicant traverses this assertion for at least the following reasons:

- 1) An interview is at the option/request of the applicant. The purpose of an interview is to help the applicant. It seems inconsistent with Office procedures for an examiner to try to use the interview process to try to collect an "acquiesce" from an applicant.
- 2) Since the time period available during the interview is very limited, an applicant must choose to focus in on certain issues and hence to deliberately ignore and avoid going off on a tangent on other issues.

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3) The applicant has no recognition of such an acquiesce and does not recognize that this occurred during the interview.

4) The alleged acquiesce was not mentioned in either the "Examiner Interview Summary (PTOL-413)" or in the applicant's interview summary included in the Applicant's earlier response.

As in previous applicant's replies, the applicant continues to traverse the Office Action assertion. The applicant believes that the prosecution should be based on the actual prior art at the time of the applicant's invention, and not be based on opinion or generalized statements of the prior art that are created by the Office. And that it is more helpful to the Applicant, if the Office cites the specific locations in the prior art, where each of the elements of the applicant's claimed invention are found.

Response:

Per section 3 of the Office action mailed 2/5/2008:

“Applicant's arguments filed 7/8/2008 with respect to the Admission of prior art set forth in section 5 of the previous Office action mailed 4/9/2008 have been fully considered but they are not persuasive.

A thorough review of Amendment D received 10/29/2007 provides no support for applicant's allegations that the Examiners contention has been overcome. There does not appear to be any argument of record made by applicant to support the alleged traversal of the admission of prior art. To ensure clarity, the original rejection is repeated below (and sustained herein):

Admission of Prior Art under MPEP § 2144.03 [R-1] C

Because applicant failed to traverse the Examiner's assertion of what is common knowledge or well known in the art the following item(s) is/are, from this point forward, to be considered prior art:

5. From page 5 of the previous Office action (mailed 7/31/2007) “...the Examiner takes Official Notice that it was well known at the time of invention to one of ordinary skill that iTunes coupled with an iPod or other networked computers generated, consolidated and distributed musical compositions, playlists (including "Smart Playlists") and user usage data (such as "Ratings") to tailor Smart Playlists to the user at any device on the media network, and that customization and tracking information was recorded individually by each user's own iTunes Library.”

A complete review of ALL applicant's arguments does not indicate a traversal of the specific limitations set forth above, i.e. that

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iTunes coupled with an iPod or other networked computers generated, consolidated and distributed musical compositions, playlists (including "Smart Playlists") and user usage data (such as "Ratings") to tailor Smart Playlists to the user at any device on the media network, and that customization and tracking information was recorded individually by each user's own iTunes Library.

In other words, it was known at the time of the invention to have a mobile device sync up with all of a users devices and update any changes, including playlists, additional music, rights to said additional music, preferences, etc. All of applicant's arguments are directed at how the inventions allegedly do no read on the claimed invention of how the music is selected, NOT the feature of networking interconnectivity between a single users multiple devices. (e.g. cell phone, pda, home desktop computer, laptop, etc., etc. etc.) to provide seamless access to digital information and users "preferences" ("preferences" including not only the playlists and ratings set to the music in iTunes, but all other "preferences" computerized devices allow for, i.e. login scripts, background colors or pictures, hot keys, etc., etc., etc.)

An adequate traversal must be directed towards the specific limitations being traversed, not generically towards a reference itself.

Accordingly since applicant has failed to adequately traverse the Examiners contention, it is again considered prior art from this point forward. An adequate traversal must be directed towards the specific limitations being traversed.

Here again, applicant has failed to adequately traverse the Examiners contention because no evidence or reasoning has been proffered to explain why the networking connectivity described above is in err. For an adequate traversal, applicant MUST provide evidence and or arguments directed specifically towards the networking connectivity between a single users multiple devices as described inter alia above.

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4. **Applicant's arguments, see pages 13-22, filed 8/15/2009, with respect to the rejections of claims 163-179 and 206-231 under 35 USC 102(b)/103(a) set forth in sections 8 and 9 of the previous Office action mailed 4/16/2009 have been fully considered and are persuasive.** Accordingly the rejections of said sections 8 and 9 of said 4/16/2009 Office action are hereby withdrawn.

5. **Applicant's arguments with respect to the rejection set forth in section 10 (35 USC 103(a) Plastina rejection) of the previous Office action mailed 4/16/2009 have been fully considered but they are not persuasive.**

A. Applicant argues on page 23:

“A) Applicant believes that the Office has not established a prima facie case of obviousness: The Office Action only provided a single listing of figures and columns/lines but did not show where each element in the applicant's independent claims can be found in Plastina. Hence, the Office has not satisfied the requirements needed to establish a prima facie case of obviousness for the independent claims.

In addition, for the dependent claims, the Office Action only asserts in a general way that "these limitations are considered obvious variants ...". The Office has not cited where each of the elements in the applicant's dependent claims are found in Plastina. Hence, the Office has not satisfied the requirements needed to establish a prima facie case of obviousness for the dependent claims.”

A. Response:

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

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Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The Examiner cited particular columns and line numbers in the references as applied to the claim(s) as nearly as practicable. Although the specified citations are representative of the teachings in the art as applied to the specific limitations within the individual claim(s), other passages and figures may apply as well.

The statement of rejection set forth in said section 10 is over the ENTIRE Plastina reference and NOT just the portions cited, Applicant must fully consider the reference in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner. See MPEP 2260 [R-5], and 37 CFR 1.104(c)(2)

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified”

In re Shepard, 138 USPQ 148 (CCPA 1963)

“In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the reasonable inferences which one skilled in the art would logically draw therefrom.”

In re Dance (CA FC) 48 USPQ2d 1635 (10/30/1998)

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“When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. “

In re Wood, 202 USPQ 171 (CCPA 1979)

“In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved”

Lamont v. Berguer, 7 USPQ2d 1580 (BdPatApp&Int 1988)

“In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved”

As evidenced by the above case law citations, it is presumed that

Applicant is aware of the references of record and that citing specific areas therewithin should not be necessary.

Applicant argues inter alia pages 23-27:

“The manual entry of a rating by the user is not "control actions by a user" as in the applicant' claims.”

“Hence, Plastina does not have, at least, the following elements in the Applicant's independent claims:

- a) details of control actions by a user on pieces or compositions;
- b) wherein said control actions are user actions that:
 - affect the current playback of a piece or composition, or
 - find or select a piece or composition, or
 - designate a piece or composition for playback;

c) wherein the magnitude of the rating for the associated piece or composition was determined by using at least some details of control actions by the user on the associated piece or composition.”

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Response:

With regard to applicant's argument, "The manual entry of a rating by the user is not "control actions by a user" as in the applicant' claims." Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are NOT imported into the claims. The Examiner must give the claim language the broadest reasonable interpretation the claims allow.

See MPEP 2111.01, which states

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims **must be interpreted as broadly as their terms reasonably allow**. In re American Academy of Science Tech Center, F.3d, 2004 WL 1067528 (Fed. Cir. May 13, 2004)

In this case, Applicant admits that Plastina does indeed teach "The manual entry of a rating by the user" in, for example, Col. 9, lines 15-24. Plastina clearly discloses that ratings "affect the current playback of a piece or composition" in, for example, Col. 8, lines 16-20, reproduced immediately below:

By developing metadata and associating, in some way, the metadata with the content that a user experiences, the user can be provided a rich and robust media experience. This will become more clear below.

Accordingly, Plastina does indeed read on the claimed invention as it satisfies AT LEAST ONE of the "control action" limitations set forth in at least claim 163.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 163-170, 174-176, 211-213, 217-218 and 232-251 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 163 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

The omitted steps are: the act of “custom selection” set forth in the last limitation of the claim, i.e. “initiating the playback of at least one piece or composition, **that was custom** selected for said user by using said users ratings”. The claim is understood to set forth that the selection was already made prior to initiation of the playback.

Applicant’s 8/15/2009 amendment added the language in question.

Claims 164-170, 174-176, 211-213, 217-218 and 232-251 are rejected for their dependence on rejected base claim 163.

Claim Rejections - 35 USC § 103

8. Claims 163-170, 174-176, 211-213, 217, 218 and 232-263 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,941,324 to Plastina et al. (Plastina) for the reasons set forth in section 10 of the previous Office action mailed 4/16/2009.

See the discussion set forth in section 5 above.

New claims 232-263 have been reviewed and are rejected in parallel with claims 163 and its dependents.

Regarding claims 163, 252, 256 and 260, Plastina discloses an apparatus-implemented method for personalized music or entertainment, the method comprising:

(1) capturing, at a user-device, details of control actions (known as metadata) by a user on pieces or compositions; wherein said control actions:

- affect the current playback of a piece or composition, or
- find or select a piece or composition, or
- designate a piece or composition for playback;

(2) storing in one or more memories, a plurality of ratings associated with the user; wherein a rating, indicating a magnitude of preference of the user, is associated with each piece or composition; wherein the magnitude of the rating for the associated piece or composition was determined by using at least some of the details of control actions by the user on the associated piece or composition

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(3) initiating, the playback of at least one piece or composition that was custom selected for said user by using said user's ratings, in for example, the Abstract reproduced and expounded upon immediately below,

“Various systems and methods described above permit a user's content experience (e.g. music playing experience) to be monitored (corresponds to limitation (1) above, monitoring=capturing) and for metadata describing this experience to be collected. This metadata can be dynamically updated (corresponds to limitation (2) above, update=storing) as a user experiences media content and then used to impart (corresponds to limitation (3) above, impart=initiating) to the user a personalized experience that is tailored to that specific user. A user's metadata can, in some instances, be provided across a wide variety of computing devices on which the user may experience the media content, thus standardizing the user's personalized media experience. In addition, intelligent or "smart" playlists can be provided which, in some instances, can be dynamically and automatically updated to reflect current user experiences, thus providing a highly personalized and enjoyable content experience. “

Plastina does not appear to specifically disclose that the control actions are user actions that affect the playback of a piece or composition **in the same manner as applicant**.

Plastina does however set forth in, for example, Col. 8, lines 1-65, a multitude of parameters that are monitored as well as the telling statement "The examples given below are intended as examples only and should not be construed to limit the parameters or types of parameters that can be utilized."

At the time of the invention it would have been obvious to one of ordinary skill in the art to apply the teachings of Plastina with regard to the user parameters that are monitored and have modified Plastina to include parameters that affect the playback, search, selection, or designation of a piece or composition. One would have been

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motivated to make such a modification for the benefits of more accurately monitoring user habits for the benefit of selecting compositions to be played for the user that are more in tune with the users preferences..

Regarding claims 164-170, 174-176, 211-213, 217, 218 and 232-263, each of these claims sets forth a variation of the manner in which the rating is determined or the claimed invention. However, each of these limitations are either disclosed outright within the reference itself or can be considered obvious variants of collecting user “preferences” and as such would have been obvious to one of ordinary skill in the art at the time the invention was made because Plastina is concerned with providing a highly customized and enjoyable "smart" playlists modified by the metadata collected from the users experience.

9. Claims 163-170, 174-176, 211-213, 217, 218 and 232-263 are rejected under 35

U.S.C. 103(a) as being unpatentable over U.S. Patent 5,732,216 to Logan et al. (Logan)

New claims 232-263 have been reviewed and are rejected in parallel with claims 163 and its dependents.

Regarding claims 163, 252, 256 and 260, Logan discloses an apparatus-implemented method for personalized music or entertainment, the method comprising:

(1) capturing, at a user-device, details of control actions (known as metadata) by a user on pieces or compositions; wherein said control actions:

- affect the current playback of a piece or composition, or

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- find or select a piece or composition, or
- designate a piece or composition for playback;

(2) storing in one or more memories, a plurality of ratings associated with the user; wherein a rating, indicating a magnitude of preference of the user, is associated with each piece or composition; wherein the magnitude of the rating for the associated piece or composition was determined by using at least some of the details of control actions by the user on the associated piece or composition

(3) initiating, the playback of at least one piece or composition that was custom selected for said user by using said user's ratings, in for example, the Abstract (reproduced and expounded upon immediately below), Figures 1, 3, 4, Col. 1, lines 42-49 and 55-58, Col. 2, lines 24-46, Col. 4 lines 59+, Col. 5 lines 12-15, 35-45 and 60+, Col. 6, lines 8-67, etc.

“An audio program and message distribution system in which a host system organizes and transmits program segments to client subscriber locations. The host organizes the program segments by subject matter and creates scheduled programming in accordance with preferences associated with each subscriber (reads on limitation (3) above). Program segments are associated with descriptive subject matter segments, and the subject matter segments may be used to generate both text and audio cataloging presentations to enable the user to more easily identify and select desirable programming. A playback unit at the subscriber location reproduces (reads on limitation (3) above, reproduces=initiating) the program segments received from the host and includes mechanisms for interactively navigating among the program segments. A usage log is compiled to record the subscriber's use of the provided program materials, to return data to the host for billing, to adaptively modify the subscriber's preferences based on actual usage (reads on limitations (1) and (2) above, capturing and storing=usage log), and to send subscriber-generated comments and requests to the host for processing. Voice input and control mechanisms included in the player allow the user to perform hands-free navigation of the program materials and to dictate comments and

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messages which are returned to the host for retransmission to other subscribers. “

Logan does not appear to specifically disclose that the control actions are user actions that affect the playback of a piece or composition **in the same manner as applicant.**

Logan does however set forth in, for example, Figure 3, Columns 9-14, etc. a multitude of parameters that are monitored including volume, skip, rewind, etc..

At the time of the invention it would have been obvious to one of ordinary skill in the art to apply the teachings of Logan with regard to the user parameters that are monitored and have modified Logan to include parameters that affect the playback, search, selection, or designation of a piece or composition.

One would have been motivated to make such a modification for the benefits of more accurately monitoring user habits for the benefit of selecting compositions to be played for the user that are more in line and accurately reflect the user's preferences..

Regarding claims 164-170, 174-176, 211-213, 217, 218 and 232-263, each of these claims sets forth a variation of the manner in which the rating is determined or the claimed invention. However, each of these limitations are either disclosed outright within the reference itself or can be considered obvious variants of collecting user “preferences” and as such would have been obvious to one of ordinary skill in the art at the time the invention was made because Logan is concerned with organizing the program segments by subject matter and creating scheduled programming in accordance with preferences associated with each subscriber.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tsutsumi and Herberger et al. disclose systems of manipulating musical/entertainment data.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE JR. whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./

Examiner, Art Unit 3694

2009-11-09

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694